

REMARKS/ARGUMENTS

Upon entry of this response, which does not amend the claims, claims 20-25 remain pending. Claims 20-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over May, U.S. Patent No. 5,815,168, in view of Lu et al., U.S. Patent No. 5,781,200. Reconsideration in view of the following remarks is respectfully requested.

All of the claim rejections rely at least in part on Lu, U.S. Patent No. 5,781,200, which was filed August 8, 1996. In accordance with 37 CFR §1.131, Applicant respectfully traverses the rejection of claims 20-25, on the grounds of prior invention by Applicant. The present application claims the benefit of provisional application No. 60/023,955, filed August 9, 1996. Thus, the Lu reference, which was filed one day before the effective filing date of the present application, qualifies as prior art only under 35 U.S.C. §102(e). According to 37 CFR §1.131, under these circumstances, Applicant may overcome the rejection by establishing prior invention of the claimed subject matter, thereby removing the reference as prior art.

Applicant submits herewith declarations by Dr. Robert J. Probsting, inventor of the claimed invention, and Mr. Babak S. Sani, the attorney who filed the provisional application to which the present application claims priority, together with supporting Exhibits A-C. This evidence establishes "conception of the invention prior to the effective date of the reference coupled with due diligence from said date to ... the filing of the application" in accordance with 37 CFR §1.131(b).

Conception prior to August 8, 1996, is clearly established. As stated in both declarations, Provisional Application No. 60/022,729, which describes the invention claimed in claims 20-25 of the present invention, was filed on July 29, 1996. The content of this provisional application demonstrates that Dr. Probsting had conceived the invention claimed in pending claims 20-25 on or prior to July 29, 1996, i.e., prior to the effective date of Lu. Applicant believes that Provisional Application No. 60/022,729 is available in the USPTO files and therefore has not submitted a copy of the application. Applicant will furnish a true copy if it would be helpful to the Examiner.

Application No. 09/439,061
Amendment dated March 18, 2004
Reply to Office Action of September 25, 2003.

PATENT

Due diligence during the one-day period from the effective date of the reference (August 8, 1996) to the effective filing date of the present application (August 9, 1996) can be inferred from the declaration of Mr. Sani. As stated therein, subsequently to filing the application on July 29, 1996, it was discovered that a document ("Appendix A") referenced in the specification had been inadvertently omitted from the filing. When this was brought to Mr. Sani's attention, he promptly corrected the omission by filing the provisional application (No. 60/023,955) to which the present application claims priority. While the exact date of discovery of the omission is not documented in the attached evidentiary materials, it is indisputable that the corrected provisional application was filed just eleven days after the first filing. This short time interval shows that Applicant was acting with due diligence to file a patent application during the requisite one-day period.

For at least these reasons, withdrawal of all claim rejections based in whole or in part on Lu and allowance of claims 20-25 is respectfully requested. It is noted that this response is not a concession as to the merits of the rejections, and Applicant reserves the right to submit further remarks distinguishing the claims from the cited art.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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Attachments
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